

DAC

Our Ref. No.: 82225.P0189R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

M. Powell et al.

Serial No.: 08/887,680

Filed: July 3, 1997

For: **METHOD AND APPARATUS FOR
EXTENDING COMPUTER
ARCHITECTURE FROM 32 TO 64 BITS**



X X

**RENEWED PETITION IN VIEW OF DECISION REFUSING
STATUS UNDER 37 CFR 1.47(a)**

Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

Sir:

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PATENT EXENSION
PATENTS

This renewed Petition is filed in response to a Decision mailed July 2, 1999. In the Decision, it is noted that the Petition previously submitted does not clearly establish that the non-signing inventors have refused to sign the Declaration. However, as noted in the prior petition, co-inventors Powell, Cmelik, Ditzel and Kelly were mailed copies of the application under a letter requesting that they execute a provided Declaration. In the prior petition, reference was made to copies of the letters being attached as Exhibit 1, but the Office noted that such copies were not found in the Patent and Trademark Office file. In this connection, attached as Exhibit 1 hereto are copies of letters dated October 21, 1997 to co-inventors Powell, Cmelik, Ditzel and Kelly referencing enclosures of U.S. Patent No. 5,430,864, new Claims 17-38, and Declaration and Power of Attorney for reissue application. The undersigned sent such letters to the last known addresses of each co-inventor. As of

the date last written below, co-inventors Powell, Cmelik, Ditzel and Kelly have not returned the Declaration, or otherwise contacted the undersigned regarding the October 21, 1997 letter.

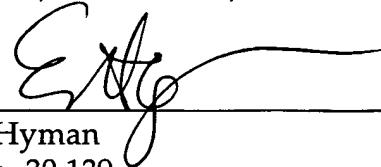
Submitted herewith is a combined Declaration and Power of Attorney signed by Shing Kong, one of the co-inventors who signed the original Declaration. In the present Declaration, it is clarified that Mr. Kong is signing on behalf of all of the inventors pursuant to 37 CFR 1.63.

It is submitted that the foregoing is responsive to item (1) clearly establishes that the non-signing inventors have refused to sign the Declaration as the non-signing inventors were presented with a copy of the application papers, and were requested to sign a Declaration, and did not respond to the request. Further, as to item (2) it is submitted that the Declaration presented herewith is in compliance with 37 CFR 1.63 and 1.64 in satisfaction of 37 CFR 1.47(a) and 35 USC 116, second paragraph.

It is noted that the petition fee was previously charged to deposit account 02-2666. In the event any additional petition is required, please charge deposit account 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN



Date July 30, 1999

Eric S. Hyman
Reg. No. 30,139

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-380

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks, Washington, D.C.

Lynda Shapiro 7/30/99
Lynda Shapiro Date

EXHIBIT 1

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OF COUNSEL
STEPHEN L KING
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NORMAN ZAFMAN

October 21, 1997

David Ditzel
4010 Page Mill Road
Los Altos Hills, CA 94322

Re: United States Patent for
METHOD AND APPARATUS FOR EXTENDING COMPUTER
ARCHITECTURE FROM 32 TO 64 BITS
Our File No.: 32235, P0139R

Dear Mr. Ditzel:

This is with reference to the above-identified U.S. patent of which you are one of the co-inventors along with Michael Powell, Robert Cmelik, Edmund Kelly and Shing Kong. This letter is also being sent to the other co-inventors.

The patent (copy enclosed), which issued in 1994, was based on an application originally filed in December 1990. The patent issued with 17 claims which include as a claim element a limitation which provides that a transfer of data values takes place if the most significant bit of the stack pointer register indicates a first word size. See for example Claim 1 in column 9 of the patent at line 65. This limitation was added during the prosecution of the application by the attorney who was handling the prosecution at that time.

Based upon a recent review of this patent by Steve Chessin, who is still with Sun, it was determined that this limitation was unnecessarily limiting and did not reflect Sun's implementation of the system which, with respect to this claim element, utilizes the least significant bit instead of the most significant bit of the stack pointer register. Additionally, as a result of this implementation, there is no need to set a width indication bit as also indicated in Claim 1.

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David Ditzel
October 21, 1997
Page 2

For this reason, we are attempting to add to the patent, a new set of Claims, 17-38, a copy of which is also enclosed.

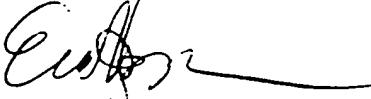
In order to enable us to have these amendments considered by the Patent and Trademark Office, it is necessary for the original inventors to execute a Declaration which explains how the errors occurred, indicates that the errors arose without any deceptive intention, and specifies when and how they were discovered and how the amendments overcome the errors.

Accordingly, please review the new Claims 17-38 and the enclosed Declaration and, if all is in order, please sign and date the Declaration where indicated at page 4.

If you have any questions at all, please do not hesitate to call me at (310) 207-3300 or Steve Chessin at Sun Microsystems.

Very truly yours,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN


Eric S. Hyman

ESH/lss

enclosures: 1) U.S. Patent No. 5,430,864
2) New Claims 17-38
3) Declaration and Power of Attorney for Reissue Application

cc: Matt Rainey, Esq. (w/enclosures 2 & 3)
Steve Chessin (w/enclosures 2 & 3)

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OF COUNSEL
STEPHEN L KING
RONALD W READIN
NORMAN ZAFMAN

October 21, 1997

Edmund Kelly
5277 Rio Grande Drive
San Jose, CA 95136

Re: United States Patent for
**METHOD AND APPARATUS FOR EXTENDING COMPUTER
ARCHITECTURE FROM 32 TO 64 BITS**
Our File No.: 82225, P0189R

Dear Mr. Kelly:

This is with reference to the above-identified U.S. patent of which you are one of the co-inventors along with Michael Powell, Robert Cmelik, David Ditzel and Shing Kong. This letter is also being sent to the other co-inventors.

The patent (copy enclosed), which issued in 1994, was based on an application originally filed in December 1990. The patent issued with 17 claims which include as a claim element a limitation which provides that a transfer of data values takes place if the most significant bit of the stack pointer register indicates a first word size. See for example Claim 1 in column 9 of the patent at line 65. This limitation was added during the prosecution of the application by the attorney who was handling the prosecution at that time.

Based upon a recent review of this patent by Steve Chessin, who is still with Sun, it was determined that this limitation was unnecessarily limiting and did not reflect Sun's implementation of the system which, with respect to this claim element, utilizes the least significant bit instead of the most significant bit of the stack pointer register. Additionally, as a result of this implementation, there is no need to set a width indication bit as also indicated in Claim 1.

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Edmund Kelly
October 21, 1997
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For this reason, we are attempting to add to the patent, a new set of Claims, 17-38, a copy of which is also enclosed.

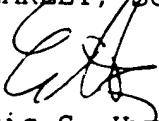
In order to enable us to have these amendments considered by the Patent and Trademark Office, it is necessary for the original inventors to execute a Declaration which explains how the errors occurred, indicates that the errors arose without any deceptive intention, and specifies when and how they were discovered and how the amendments overcome the errors.

Accordingly, please review the new Claims 17-38 and the enclosed Declaration and, if all is in order, please sign and date the Declaration where indicated at page 4.

If you have any questions at all, please do not hesitate to call me at (310) 207-3800 or Steve Chessin at Sun Microsystems.

Very truly yours,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN


Eric S. Hyman

ESH/lss

enclosures: 1) U.S. Patent No. 5,430,864
2) New Claims 17-38
3) Declaration and Power of Attorney for Reissue Application

cc: Matt Rainey, Esq. (w/enclosures 2 & 3)
Steve Chessin (w/enclosures 2 & 3)

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STEPHEN L. KING
RONALD W. REAGIN
NORMAN ZAFMAN¹⁵

October 21, 1997

Robert Cmelik
1024 Chula Vista Terrace
Sunnyvale, CA 94086

Re: United States Patent for
**METHOD AND APPARATUS FOR EXTENDING COMPUTER
ARCHITECTURE FROM 32 TO 64 BITS**
Our File No.: 82225, P0189R

Dear Mr. Cmelik:

This is with reference to the above-identified U.S. patent of which you are one of the co-inventors along with Michael Powell, David Ditzel, Edmund Kelly and Shing Kong. This letter is also being sent to the other co-inventors.

The patent (copy enclosed), which issued in 1994, was based on an application originally filed in December 1990. The patent issued with 17 claims which include as a claim element a limitation which provides that a transfer of data values takes place if the most significant bit of the stack pointer register indicates a first word size. See for example Claim 1 in column 9 of the patent at line 65. This limitation was added during the prosecution of the application by the attorney who was handling the prosecution at that time.

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Robert Cmelik
October 21, 1997
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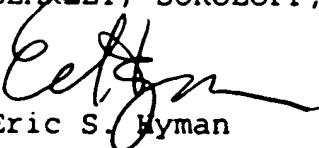
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Very truly yours,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN


Eric S. Hyman

ESH/lss

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NORMAN ZAFMAN*

October 21, 1997

Michael Powell
2305 Emerson Street
Palo Alto, CA 94301

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**METHOD AND APPARATUS FOR EXTENDING COMPUTER
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Michael Powell
October 21, 1997
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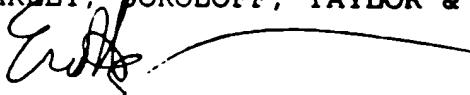
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